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10/804,000	03/19/2004	Masanori Itoh	250792US2	6923
22850	7590	07/29/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
PARK, CHAN S				
ART UNIT		PAPER NUMBER		
2625				
NOTIFICATION DATE		DELIVERY MODE		
07/29/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

Application No.

10/804,000

Applicant(s)

ITO ET AL.

Examiner

CHAN S. PARK

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of Species I (Claim 1-24) in the reply filed on 4/23/08 is acknowledged.

***Claim Objections***

2. Claims are objected to because of the following informalities:

Claim 3, lines 4-5, "to service data" should be -- from service data --;

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 19-23** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 19-23 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

Also, refer to page 53 of the Interim Guideline.

Claims 19-23, while defining a computer program product, do not define a "computer-readable medium" and is thus non-statutory for that reason. A computer program product can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to state, "A computer-readable medium encoded with a computer program..." in order to make the claim statutory. Upon amending the claims as suggested, claim 24 should be canceled.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claim 1** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites limitations of "at least one of reservation information" and "a document related to a print reservation". It is unclear if these two reservations are same or related. Clarification/explanation from the Specification is respectfully requested.

**Claim 2** recites the limitation "service data including other sharing units". It is unclear how service data can include physical units. Clarification/explanation from the Specification is respectfully requested.

**Claim 4** recites the limitation of managing the data "as one of upper level data, same level data, and lower level data". It is unclear what kind of level it is referring to.

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With respect to what is it upper, same or lower? Does the level indicate the relation between the first sharing unit and the second sharing unit? Or does it indicate the relation between the second sharing unit and other sharing units? Although the data is managed based on the relation between the first and second sharing unit, it is still unclear as to what it means by "upper", "same", and "lower" level. For examining purpose, the different levels are construed as different groups.

**With respect to claims 14 and 19**, arguments analogous to those presented for claim 1, are applicable.

**With respect to claims 17 and 22**, arguments analogous to those presented for claim 4, are applicable.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-12 and 14-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima U.S. Patent No. 7,215,437 in view of Arakawa U.S. Patent Application Pub. No. 2002/0054339.

**With respect to claim 1**, Shima discloses an apparatus (server computer 1 in fig. 1), comprising:

a first sharing unit that shares a print environment thereof with other apparatuses (fig. 1 including a printer 3),

wherein the first sharing unit includes:

a connection management unit that manages the connecting of the first sharing unit to a second sharing unit of another apparatus (server authenticating the connection with the printer 3 in col. 6, lines 3-7 & lines 43-45); and

a transfer unit that transfers a document to the second sharing unit (col. 8, lines 39-49).

Shima, however, does not explicitly disclose that the transfer unit transfers at least one reservation information and a document related to a print reservation to the second sharing unit.

Arakawa, the same field of endeavor of the network printing via the server, discloses a transfer unit that transfers at least one of reservation information and a document related to a print reservation to the printer unit (paragraphs 93 & 138).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the server of Shima to store and transmit at least one of reservation information and a document related to a print reservation to the printer unit.

The suggestion/motivation for doing so would have been to provide a printing system where a server reserves/stores the print jobs for later printing.

Therefore, it would have been obvious to combine Shima with Arakawa to obtain the invention as specified in claim 1.

**With respect to claim 2**, Shima discloses the apparatus,

wherein the connection management unit adds connection data related to the second sharing unit to service data including other sharing units that are connected to the first sharing unit in response to a connection request from the second sharing unit (adding the printer information upon logged in to the server computer in col. 6, lines 46-59).

**With respect to claim 3**, Shima discloses apparatus,

wherein the connection management unit deletes connection data related to the second sharing unit to service data including other sharing units that are connected to the first sharing unit upon detecting the disconnection from the second sharing unit (deleting the printer information from the printer management table upon detecting the disconnection in col. 7, lines 4-9 & col. 13, lines 54-67). Shima, however, does not explicitly teach the step of requesting the disconnection from the printer. Since Shima teaches the method of requesting the SSL session request from the printer, the examiner takes an Official Notice that requesting the SSL session disconnection request (such as log out request) is also well-known in the network printing art. Therefore, it would have been obvious to one of ordinary skill in the art to modify the printer of Shima to include the disconnection request method to manually disconnect the printer from the server.

**With respect to claim 4**, Shima discloses the apparatus,

wherein the connection data related to the second sharing unit added to the service data are managed as one of upper level data, same level data, and lower level data depending on a relation between the first sharing unit and the second sharing unit

(note that the printers are managed based on which organization they belong to in col. 6, lines 24-36).

**With respect to claim 5**, Shima discloses the apparatus, further comprising: a service data storage unit that stores the service data (storage that stores the printer management table in col. 6, lines 37-45).

**With respect to claim 6**, Shima discloses the apparatus, wherein the first sharing unit further comprises: an acquisition unit that acquires the service data from the second sharing unit (col. 6, lines 3-7).

**With respect to claim 7**, Shima discloses the apparatus, wherein the first sharing unit further comprises:

a consistency check unit that checks consistency of a connection state in which the second sharing unit is connected to the first sharing unit and a disconnection state in which the second sharing unit is disconnected from the first sharing unit (col. 6, line 60 ~ col. 7, line 8).

**With respect to claim 8**, Arakawa discloses the apparatus, further comprising: a reservation data storage unit that stores the reservation information and the document (paragraphs 93 & 138).

**With respect to claim 9**, Shima discloses the apparatus, further comprising: a document acquisition unit that acquires the document (col. 8, lines 39-48).

**With respect to claim 10**, Shima discloses the apparatus, further comprising: a document management service unit that provides a service for managing the document (col. 8, lines 39-48).



**With respect to claim 11**, Shima discloses the apparatus, further comprising: a document storage unit that stores the document (the document must be stored in the server before the transmission to the printer in col. 6, lines 37-45 & col. 8, lines 39-48).

**With respect to claim 12**, Shima discloses the apparatus, further comprising: a print service unit that provides service related to printing (col. 6, lines 37-45 & col. 8, lines 39-48).

**With respect to claims 14, 19 and 24**, arguments analogous to those presented for claim 1, are applicable.

**With respect to claims 15 and 20**, arguments analogous to those presented for claim 2, are applicable.

**With respect to claims 16 and 21**, arguments analogous to those presented for claim 3, are applicable.

**With respect to claims 17 and 22**, arguments analogous to those presented for claim 4, are applicable.

**With respect to claims 18 and 23**, arguments analogous to those presented for claim 5, are applicable.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Shima and Arakawa as applied to claim 1 above, and further in view of Cantwell U.S. Patent No. 6,542,892.

**With respect to claim 13**, the combination discloses the apparatus as claimed in claim 1, but it does not explicitly disclose a print unit that prints the document.

Cantwell, the same field of endeavor of the network printing art, discloses a server having an embedded printer for printing documents (col. 2, lines 20-24).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the server of Shima to include the printer for printing the document as taught by Cantwell.

The suggestion/motivation for doing so would have been to provide a server for printing the document locally.

Therefore, it would have been obvious to combine three references to obtain the invention as specified in claim 13.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571)272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHAN S PARK/  
Examiner, Art Unit 2625

July 18, 2008